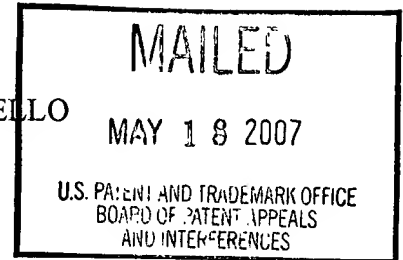


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte: BRIAN SIEGEL and THOMAS MARCHESE LLO

Application No. 09/745,669



ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received at the Board of Patent Appeals and Interferences on April 18, 2007. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being returned to the examiner. The matters requiring attention prior to docketing are identified below.

APPEAL BRIEF

An Appeal Brief was filed on June 26, 2006, under the rules set forth in 37 CFR 41.37(c). However, a review of the Appeal Brief reveals that it is not in compliance with the new rules under 37 CFR 41.37(c), which states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief

filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section.

A review of the appellant's Appeal Brief reveals that the following required appendices are missing:

37 CFR § 41.37(c)(1)(ix), which is identified in the new rules as:

(ix) ***Evidence appendix***. An appendix containing copies of any evidence submitted pursuant to 1.130, 1.131, 1.132 of this title or of any other evidence entered by the examiner and relied upon by appellant in the appeal, along with a statement setting forth where in the record that evidence was entered in the record by the examiner. Reference to unentered evidence is not permitted in the brief. See § 41.33 for treatment of evidence submitted after appeal. This appendix may also include copies of the evidence relied upon by the examiner as to grounds of rejection to be reviewed on appeal.

and

37 CFR § 41.37(c)(1)(x), which is identified in the rules as:

(x) ***Related proceedings appendix***. An appendix containing copies of decisions rendered by a court or the Board in any proceeding identified pursuant to paragraph (c)(1)(ii) of this section.

(2) A brief shall not include any new or non-admitted amendment, or any new or non-admitted affidavit or other evidence. See 1.116 of this title for amendments, affidavits or other evidence filed after final action but before or with any appeal and § 41.33 for amendments, affidavits or other evidence filed after the date of the appeal.

Section 37 CFR § 41.37(c) further states:

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

It is required that a substitute Appeal Brief be submitted that is in compliance with 37 CFR 41.37(c).

EXAMINER'S ANSWER

Evidence of Record

On September 27, 2006, an Examiner's Answer was mailed in response to the Appeal Brief received June 26, 2006. A review of the Examiner's Answer reveals that it is not in compliance with the Manual of Patent Examining Procedure (MPEP). In the "Evidence Relied Upon" (section 8) the Examiner identifies evidence or prior art not specifically relied upon in the rejection of the claims on appeal. In accordance with MPEP 1207.02, the "Evidence Relied Upon" (section 8) should include:

(8) Evidence Relied Upon

A listing of evidence relied on (e.g., patents, publications, admitted prior art), and in the case of non-patent references, the relevant page or pages.

Correction of the record is required.

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Additionally, the Examiner should ensure that a copy of all references identified as prior art is scanned into IFW for consideration by the Board of Patent Appeals and Interferences.


CONCLUSION

Accordingly, it is

ORDERED that the application is returned to the examiner for:

- 1) hold the Appeal Brief filed June 26, 2006, defective;
- 2) notify appellants to file a Supplemental Appeal Brief in compliance with 37 CFR § 41.37;
- 3) vacate the Examiner's Answer mailed September 27, 2006;
- 4) issue a revised Examiner's Answer to acknowledge and consider any supplemental Appeal Brief and all required headings as set forth under 37 CFR § 41.37; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS AND INTERFERENCES



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